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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/813,247	03/07/1997	MITSUHIRO AIDA		3212

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MITSUHIRO AIDA
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EXAMINER

HONG, STEPHEN S

ART UNIT PAPER NUMBER

2178

DATE MAILED: 05/06/2003

58

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/813,247

Applicant(s)
Aida

Examiner
Stephen Hong

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2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 12, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-121 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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Part III DETAILED ACTION

1. This action is responsive to communications: RCE and preliminary amendment filed on February 12, 2003 to the application, filed on 3/7/97, which is a continuation of 08/330,573, filed on 10/28/94.
2. In the amendment claims 104-121 are added. Accordingly, claims 84-121 are pending in this case. Claims 84, 94, 104, 109, 113 and 118 are independent claims. It is requested that Applicant clarify the status of claims 84-103, since the arguments filed on 2/12/03 appear to suggest that the claims are canceled in view of the newly added claims 104-121. However, there does not appear to be an explicit statement for canceling the claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

Drawings

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

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Specification

5. Examiner requests that Applicant review the application carefully for informalities including typographical errors and awkward languages that may resulted from translation.

Claim Rejections - 35 USC § 112

6. Claims 84-103 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per independent claims 84-103, the claimed term “without a further special key depression” is indefinite, since it is unclear exactly what constitutes “a special key”. In other words, it is not clear which keys are considered to be the “special” keys and which keys are not considered to be special.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 84-89, 93-99 and 103 remain rejected and claims 104-108, 113-117 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Dell, U.S. Pat. No. 5,109,352, 4/92.

As per Claims 84-89, 93-99, 103, 104-108, 113-117, O'Dell discloses the claimed invention of:

entering and storing a plurality of lines of text and original words in a dictionary and replacing the entered lines of text with the unique line of text or the original word without using a special function key; identifying a plurality of lines of text with the same stem, and determining the word; random access storing the plural lines of text and the unique line of text. Referring to O'Dell, O'Dell teaches a word processor to enter a plurality of lines of text (FIG.10). O'Dell stores the plurality of characters in a Chinese or Japanese (or European) character dictionary, and allows the user to enter the strokes (item 50 in FIG.10) . FIG.5 shows the plurality of lines of words with the same initial stems, giving the user the visual feedback of the strokes entered for the character input.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103[®] and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 90-92 and 100-103 remain rejected and claims 109-112, 118-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Dell in view of Shimizu et al., U.S. Pat. No. 5,870,492, 2/99 (filed 6/92).

Claims 90-92, 100-103 and 109-112, 118-121 recite substantially similar limitations as claims 63-68, 72, 73-78, 82 and are similarly rejected. However, O'Dell does not explicitly teach the use of handwritten input. O'Dell uses the keyboard to represent the strokes for the characters (FIG.1E). Nevertheless, the use of hand writing input (e.g., using a stylus, tablet, pen) was extremely well known in the computer art at the time of the invention. With respect to the missing limitation, Shimizu teaches the following pertinent features. Like O'Dell, Shimizu teaches inputting the Chinese or Japanese characters for text processing. Shimizu explicitly points out that in inputting the Japanese characters, it is difficult to input by hand and write the characters that are similar in shapes (col.1, lines 20-30). Shimizu then teaches the solution where the candidate characters are displayed as the user inputs the strokes by hand writing (col.2, lines 1-15). Furthermore, Shimizu allows the user to select the desired character without having to use the "special character (col.2, lines 15-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have envisage using O'Dell's system to take handwritten inputs of Shimizu, in order to

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accommodate the widely used pen-based computing systems to effectively enter the foreign language characters with similar shapes.

Response to Arguments

11. Applicant's arguments filed February 12, 2003 have been fully considered but they are not persuasive.

Applicant's arguments with respect to the 35 USC 112 rejection of claims 84-103 have been considered. As mentioned above it is unclear whether or not the claims have been canceled. Assuming they are still pending, the rejection remains. The Applicant's argument is noted which says "Also, Industry Standard IBM 3270 special function keys include Enter(Return), as well as Clear, Reset, Cursor Sel, PA1-3, PF1-24, Test Request, etc, and Enter(Return) key is usually used to terminate an entry and also to activate a function." This is a good example of the indefiniteness as Examiner points out in the rejection above. The use of "etc." and "usually" suggest that the "metes and bounds" of the claimed limitation is not firmly determined.

On page 1 of the argument, Applicant states "O'Dell claims do not correspond to any claim of the present invention. Fig. 5 of O'dell shows the discovery, as stated in the O'Dell specification, in col.10, lines 20-." It is not clear what is being argued by asserting "the discovery." Nevertheless, the argument that O'Dell's claims have to correspond to the

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Applicant's claims is in error. Any part of O'Dell's reference, in addition to the claims, can be used to show an evidence of the prior art.

On page 2 of the argument, with respect to the rejection under 35 USC 103(a) as being unpatentable over O'Dell in view of Shimizu et al., Applicant argues that "Shimizu relates to the hand-written character recognition, and O'Dell does nothing for the recognition." The Applicant's arguments are not persuasive. O'Dell teaches inputting Chinese characters to a computer system using a keyboard based input. And, the reference of Shimizu was applied to show that it was well known to use a "hand-written" method to input the Chinese characters in addition to using a keyboard. Thus, the incorporation of Shimizu was to show that it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to have input O'Dell's Chinese characters using the well known hand-written input method. Thus, the Applicant's arguments are not persuasive.

Conclusion

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9724 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Stephen Hong

Primary Examiner

May 3, 2003